

REMARKS/ARGUMENTS

Claims 1-23 were pending in this application. Claims 1, 6, 13, and 16 have been amended. Claims 3, 5, and 16 have been canceled. Claims 24 has been added. Hence, claims 1, 2, 4, 6-15, and 17-24 are pending. Reconsideration of the subject application as amended is respectfully requested.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-2, 7-9, 11-14, 18-20 , and 22-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the cited portions of U.S. Patent No. 5,937,047 to Stabler, *et al.* (hereinafter “Stabler”). Claim 1 has been amended to include “charging the user a pre-determined long-distance rate in relation to the telephone call.” Stabler does not teach this. Stabler describes a voice messaging system that a business might use to process incoming calls from customers. These callers are not “charg[ed] … a pre-determined long-distance rate in relation to the telephone call” as recited by claim 1. Applicant’s claimed invention is unique in this respect. Thus, claim 1 is believed to be allowable at least for this reason.

Claims 13 and 24 include similar limitations and are believed to be allowable at least for the same reason. All remaining pending claims depend from either claim 1 or claim 13 and are thus believed to be allowable at least for the same reasons.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 3-6, and 15-17, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stabler in view of the cited portions of U.S. Patent No. 5,187,735 to Herrero Garcia, *et al.* (hereinafter “Herrero”).

Claims 10 and 21, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stabler in view of the cited portions of U.S. Patent No. 6,160,883 to Jackson, *et al.* (hereinafter “Jackson”).

The allowability of the claims rejected under 35 U.S.C. § 103(a) has been addressed above in that these claims depend from independent claims believed to be allowable. Additionally, the Applicant respectfully traverses the rejections under 35 U.S.C. § 103(a) because the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

For example, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to combine the teachings of Stabler with those of Herrero to achieve the Applicant's claimed invention. The Applicant notes that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added)

Appl. No. 09/998,557
Amdt. dated August 21, 2003
Reply to Office Action of May 21, 2003

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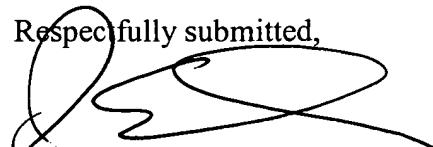
Here, the office action has merely pulled a few words from the Abstract of Herrero, namely "one stop full service telephone call," and suggested that this provides the necessary motivation. At best this amounts to impermissible hindsight. Applicant, however, contends that this negates any motivation to combine the references. The presence of these words in the Abstract of Herrero implies that, at least in the minds of the Herrero inventors, that Herrero has already provided "a one stop full service telephone call." Thus, again in the minds of the Herrero inventors, nothing more, including the teachings of Stabler, need be added to the teachings of Herrero to achieve this. Therefore, the motivation to combine the references cited in the office action is not valid.

Because no reference is cited that provides the teaching, suggestion, or motivation to combine the references, the Applicant respectfully traverses the rejection and requests either an express showing of documentary proof, a reference, or an affidavit specifically stating facts within the personal knowledge of the Examiner, as required by 37 CFR § 1.104(d)(2).

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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